

**REMARKS/ARGUMENTS**

The amendments set out above and the following remarks are believed responsive to the points raised by the Office Action dated February 2, 2006. Reconsideration is respectfully requested.

With respect to the information disclosure statement filed on May 5, 2004, an information disclosure statement is now filed that includes the reference "Testing Methods for Oxidation Stability of Lubricating Oils." Further, the Applicants apologize for including the FORM PTO-1449 for attorney docket no. AC-7657, which appears to have been done in error. The remaining information disclosure statements filed in this case were intended for this application, and the Applicants thank the Examiner for considering them.

Claims 1-10 and 42 have been canceled, and claims 11-41 and 43-45 remain pending. Independent claims 11, 22, and 32 have been amended to more clearly define the invention. For example, claim 11 has been amended to define the lubricant additive package as having a total phosphorus content of not more than about 500 ppm and as including an extreme pressure additive. Claims 22 and 32 have been amended to define the respective lubricant additive packages as having total phosphorus contents of not more than about 500 ppm. No new matter has been added, the basis for the amended claim language may be found within the original specification and claims.

Claims 1-10 and 42 were rejected under 35 U.S.C. §102 as anticipated by U.S. Patent No. 5,126,064 to Barber et al. Since claims 1-10 and 42 have been canceled, the rejection is now moot.

Claims 11-15 and 17-21 were rejected under 35 U.S.C. §102 as anticipated by U.S. Patent Application Publication No. 2001/0034305 to Komatsubara. The rejection is respectfully traversed.

Komatsubara fails to disclose each and every element of pending independent claim 11, and therefore fails to anticipate claim 11 and those claims depending therefrom. For example, independent claim 11 defines a lubricant additive package including a dispersant which is substantially free of boron, at least one inhibitor, and an extreme pressure additive, wherein the weight ratio of said dispersant to said extreme pressure additive is from about 1:7 to about 1:2. In the one comparative formulation disclosed in Komatsubara which is boron free (Komatsubara

is directed to *boron-containing* lubricant compositions) no extreme pressure additive is utilized. Furthermore, while Komatsubara does disclose that extreme pressure agents may be used in combination with the *boron-containing* dispersant, Komatsubara does not disclose or suggest utilizing an extreme pressure additive in an amount such that the ratio of the substantially boron-free dispersant to extreme pressure additive is from about 1:7 to about 1:2. Rather, Komatsubara discloses *boron-containing* dispersants present in amounts ranging from 3.3 to 6.5 wt% (see e.g., Table 1) and extreme pressure additives added in an amount of 0.01 to 5.0 wt% (see e.g., paragraph 0072), amounts which are well outside of the ratio defined in pending claim 11. Accordingly, Komatsubara cannot anticipate or suggest the lubricant additive package claimed in claim 11, and thus, the rejection cannot be maintained.

Claims 1-31 and 42-44 were rejected under 35 U.S.C. §102 as anticipated by U.S. Patent No. 3,865,739 to Waldbillig. Since claims 1-10 and 42 have been canceled, the rejection of these claims is now moot. The rejection of claims 11-31 and 43-44 is respectfully traversed.

Waldbillig fails to disclose each and every limitation of pending independent claim 11 and of pending independent claim 22, and therefore fails to anticipate those claims and those claims depending therefrom. For example, Waldbillig fails to disclose a lubricant additive package having a total phosphorus content of not more than about 500 ppm. Indeed, Waldbillig discloses compositions including from 0.1 to 5 wt% (1000-50,000 ppm) phosphorus-containing compounds, e.g., antioxidants such as hydrocarbyl dithiophosphates (see e.g., col. 5, lines 46-68).

The presently claimed additive packages having total phosphorus contents of no more than about 500 ppm advantageously provide clean performing lubricants, and as illustrated in the present specification, lubricants which pass both the ISOT test and the L60-1 test, despite the absence of boron additives. There is simply no suggestion in Waldbillig of the benefits of limiting the phosphorus content in a lubricant composition to no more than about 500 ppm. Furthermore, in view of the teaching in Waldbillig of utilizing from 0.1 to 5wt% phosphorus-containing compounds, one of skill in the art would find no suggestion to limit phosphorus content to no more than about 500 ppm. Accordingly, Waldbillig fails to disclose or suggest the lubricant compositions defined in pending independent claims 11 and 22.

Dependent claims 43 and 44 are also allowable, not only because they depend from novel and non-obvious independent claims 11 and 22, but they also define limitations not taught by

Waldbillig. For example, Waldbillig does not disclose, suggest or point to a lubricant composition that achieves a satisfying score on the ISOT test and the L60-1 test. As explained in the present specification, it is the presently claimed lubricant additive packages having a total phosphorus content of no more than about 500 ppm which pass both the ISOT test and the L60-1 test, despite the absence of boron. Since Waldbillig teaches compositions having phosphorus contents of *more than* about 500 ppm, and as much as 50,000 ppm of phosphorus, there can be no reasonable assumption that the compositions of Waldbillig would inherently achieve satisfying scores on the ISOT and L60-1 tests.

Claims 11-21, 32-41, 43 and 45 were rejected under 35 U.S.C. §102 as anticipated by U.S. Patent No. 5,922,656 to Yoshimura et al (hereinafter referred to as "Yoshimura"). The rejection is respectfully traversed.

Yoshimura fails to disclose or suggest a lubricant additive package as defined in either independent claim 11 or independent claim 32. For example, Yoshimura fails to disclose or suggest a lubricant additive package having a total phosphorus content of not more than about 500 ppm. In contrast with the presently claimed additive packages, Yoshimura is directed to lubricant compositions including as much as 1.5 wt% of acid phosphate or acid phosphite ester. Yoshimura specifically teaches the disadvantages of lubricant compositions which include less than 0.05 wt% of the acid phosphate or acid phosphite ester. For example, Yoshimura teaches that compositions including less than 0.05 wt% of the phosphorus component, "may exhibit insufficient property of preventing clogging of the friction material and its durability" (col. 9, lines 21-24). Accordingly, Yoshimura cannot anticipate or suggest the lubricant additive packages of claims 11 and 32 which have phosphorus contents of not more than about 500 ppm. Thus, it is respectfully submitted that the rejection should be withdrawn.

Dependent claims 43 and 45 are also allowable, not only because they depend from novel and non-obvious independent claims 11 and 32, but they also define limitations not taught by Yoshimura. For example, Yoshimura does not disclose, suggest or point to a lubricant composition that achieves a satisfying score on the ISOT test and the L60-1 test. As explained above, it is the presently claimed lubricant additive packages having a total phosphorus content of no more than about 500 ppm which pass both the ISOT test and the L60-1 test, despite the absence of boron. Since Yoshimura teaches compositions having phosphorus contents of *more*

*than* about 500 ppm, and as much as 15,000 ppm of phosphorus, there can be no reasonable assumption that the compositions of Yoshimura would inherently achieve satisfying scores on the ISOT and L60-1 tests.

In view of the amendments and remarks recited herein, the application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue.

If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

**FEES**

It is believed there are no fees associated with this filing. However, in the event the calculations are incorrect, the Commissioner is hereby authorized to charge any deficiencies in fees or credit any overpayment associated with this communication to Deposit Account No. 05-1372.

Respectfully submitted,

  
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Date: May 2, 2006